

12-16-05

PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**TRANSMITTAL  
FORM**

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

38

Application Number

10/648,955

Filing Date

08/27/2003

First Named Inventor

Bennett M. Richard

Art Unit

3672

Examiner Name

Giovanna M. Collins

Attorney Docket Number

D5407-188

**ENCLOSURES**

(Check all that apply)

☐

Fee Transmittal Form

☐

Fee Attached

☐

Amendment/Reply

☐

After Final

☐

Affidavits/declaration(s)

☐

Extension of Time Request

☐

Express Abandonment Request

☐

Information Disclosure Statement

☐

Certified Copy of Priority Document(s)

☐Reply to Missing Parts/  
Incomplete Application☐Reply to Missing Parts  
under 37 CFR 1.52 or 1.53☐

Drawing(s)

☐

Licensing-related Papers

☐

Petition

☐Petition to Convert to a  
Provisional Application☐

Power of Attorney, Revocation

☐

Change of Correspondence Address

☐

Terminal Disclaimer

☐

Request for Refund

☐

CD, Number of CD(s) \_\_\_\_\_

☐

Landscape Table on CD

☐

After Allowance Communication to TC

☐Appeal Communication to Board  
of Appeals and Interferences☒Appeal Communication to TC  
(Appeal Notice, Brief, Reply Brief)☐

Proprietary Information

☐

Status Letter

☒Other Enclosure(s) (please identify  
below):

Acknowledgment Postcard

**Remarks**

Filed herewith (in triplicate) is Appellant's Brief.

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm Name

Duane Morris LLP

Signature

Printed name

Gary R. Maze

Date

12/15/2005

Reg. No.

42,851

**CERTIFICATE OF TRANSMISSION/MAILING**

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below: Express Mail No. EV572318211US

Signature

Typed or printed name

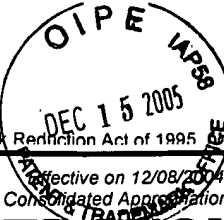
Tracie Thigpen

Date

12/15/2005

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Effective on 12/08/2004.  
Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

# FEE TRANSMITTAL

## For FY 2005

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$)  
500

### Complete if Known

Application Number	10/648,955
Filing Date	08/27/2003
First Named Inventor	Bennett M. Richard
Examiner Name	Giovanna M. Collins
Art Unit	3672
Attorney Docket No.	D5407-188

### METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): \_\_\_\_\_

☒ Deposit Account Deposit Account Number: 02-0429 Deposit Account Name: Baker Hughes Incorporated

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee

☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

### FEE CALCULATION

#### 1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

#### 2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

Total Claims	Extra Claims	Fee (\$)	Fee Paid (\$)	Multiple Dependent Claims	
- 20 or HP =	x	=		Fee (\$)	Fee Paid (\$)

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims	Extra Claims	Fee (\$)	Fee Paid (\$)
- 3 or HP =	x	=	

HP = highest number of independent claims paid for, if greater than 3.

#### 3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
- 100 =	/ 50 =	(round up to a whole number) x	=	

#### 4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Appeal Brief filing fee

Fees Paid (\$)

500

#### SUBMITTED BY

Signature	Registration No. (Attorney/Agent) 42,851	Telephone 713.402.3900
Name (Print/Type) Gary R. Maze		Date 12/15/2005

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Bennett M. Richard, et al.	§	Examiner:	Giovanna M. Collins
		§		
Serial No.:	10/648,955	§	Group Art Unit:	3672
		§		
Filing Date:	August 27, 2003	§	Attorney Docket No.:	D5407-188
		§		
Title:	Telescoping Centralizers for	§		
	Expandable Tubulars	§		

Mail Stop Appeal Brief Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**APPELLANT'S BRIEF**

12/19/2005 DEMMANU1 00000016 020429 10648955

01 FC:1402 500.00 DA

### **I. Real Party in Interest**

The real party in interest is Baker Hughes Incorporated.

### **II. Related Appeals and Interferences**

There are no related appeals and interferences.

### **III. Status of the Claims**

Claims 1-15 and 18-20 are finally rejected.

Claims 16 and 17 are allowed.

### **IV. Status of Amendments**

An Amendment After Final Rejection was mailed on 6/15/05 that did not offer claims amendments. The Examiner was not persuaded and an Advisory Action was mailed 7/8/05 indicating the continuing rejection of the claims except for claims 16 and 17 that were indicated allowed.

### **V. Summary of the Claimed Subject Matter**

Claim 1 is the only rejected independent claims. As indicated in paragraphs 12-15 of the specification and in the Figures 1-4 of this fairly straight-forward application, the method of claim 1 relates to a positioning method for a tubular 10 in a borehole indicated as 26. The method requires placing the tubular in the borehole and after the tubular is delivered the tubular 10 needs to be positioned in such a manner that an annular space exists around it. This conditioned is depicted in the drawings by showing an annulus 32 around the tubular 10. The final step is the expansion of the tubular using a schematically represented expansion tool 38, shown in Figure 2.

Claims 2-10 deal with details of the extending members which in the preferred embodiment are shown as nested pistons 20 and 22. Claims 11-15 deal with the modes of

expansion that can be used to enlarge the tubular 10. Claims 18-20 add the feature of a sealing material 28 added to the annular space 32 and expanding the tubular 10 before it sets up.

#### **VI. Grounds for Rejection to be Reviewed on Appeal**

1. Are claims 1 and 14 anticipated by Campbell USP 6,112,818?
2. Are claims 1 and 15 anticipated by Chatterji USP 6,543,545?
3. Are claims 1-5,7-13 and 18-20 rendered obvious by a combination of Chatterji USP 6,543,545 combined with Wilson USP 5,228,518?
4. Are claims 1,2,4,6, and 9 rendered obvious in view of Maguire US 2003/00447322?

#### **VII. Argument**

Claim 1 is simply not anticipated by Campbell. Claim 1 requires the tubular to be positioned downhole **“after said delivering”**. The cited reference uses a bow spring centralizer 17 that is a passive device that is intended to centralize the tubular on the way down to its ultimate depth. These devices stick out for the trip down the hole by design. Because of that feature they are also prone to snag during delivery and their operation is not entirely reliable. An additional drawback of such devices is that they impede expansion of the tubular that they surround. Additionally they can cause stress concentrations as the tubular is expanded into the surrounding centralizer top and bottom rings, that are common to bow spring centralizer designs.

The Examiner specifically points to the bow spring centralizer 17 in this reference and contends that the reference shows positioning the tubular only after it is delivered. This is clearly not the case for this reference as the bow spring centralizer is constantly in

operation during delivery. It almost seems as though the Examiner's analysis recognized the method limitation of positioning after delivering when analyzing the reference but somehow overlooked this feature of timing of the method steps and just flatly ignored it in the analysis. One example of how claim 1 works is that if a tubular is delivered to a deviated wellbore it will lie on the low point and not in the center of the bore with an annulus all around it. The method of claim 1 takes that tubular that sits on the low spot after delivery and positions it to have the annular space. The prior art bow springs centralizers can't do this as they, in theory keep the tubular centralized at all times during delivery and do no positioning at all without movement of the tubular into the well by virtue of their design. As stated before, they are also failure prone during delivery and impede expansion of the tubular they surround. Claims 1 and 14 are simply not anticipated by the Campbell reference. Claim 1 does not cover bow spring centralizers essential to Campbell's operation.

Claims 1 and 15 are not anticipated by Chatterji, either. Here again the Examiner points to a centralizer 48 that is described in column 4 lines 19-27 as segmented "fin" devices, round discs and the bow spring design that is depicted. It goes on to state the obvious that such devices are passive and that they operate "during run-in". Again, claim 1 is written to require the positioning after the delivery and for that reason does not include any of the centralizer styles described in the specification or shown in the Figures of Chatterji. The Examiner simply cannot state that this reference includes this limitation by relying on item 48 of the reference that is expressly taught to be operational during run in and subject to the downsides described with the bow spring design of Campbell, above. Claims 1 and 15 are not anticipated by Chatterji.

Next the Examiner rejects claim 1 by combining Chatterji with Wilson. Wilson shows extendable pistons that centralize after delivery. However, Wilson then delivers cement and doesn't concern himself with tubular expansion. Chatterji expands the tubular but relies on a passive centralizer that operates during delivery and has the disadvantages described above. Contrary to the Examiner's argument in the Advisory Action, one skilled in the art doesn't start from a basic reference that teaches a passive centralizer and tubular expansion and build on that design by trying to meld a completely different approach that teaches away from the basic design as to the timing of centralizing and on top of that does not even concern itself with tubular expansion. What the Examiner has done is taken bits of two different patents that address two different issues and claim that such disparate approaches can be picked apart for individual details without suggesting how a person skilled in the art would actually have the motivation to combine them. The claim 1 is directed to a method of delivering, then positioning before expanding. The Chatterji reference positions while delivering and then expands. The Wilson reference delivers and then positions but doesn't expand. The method of claim 1 overcomes the problems with passive centralizer design but does so in a context of expansion. The two discrete references do not suggest that such a context exists for the claim 1 method. Only claim 1 actually reveals the context. The Examiner simply can pick design elements from the downhole art that are drawn to different problems and solve them problems with unique approaches that have no relation to each other. Claim 1 and the other claims rejected over this combination are not obvious.

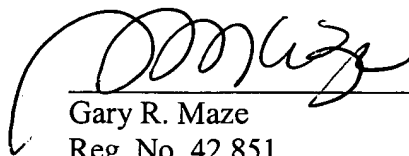
Finally, the Examiner relies on Maguire 2003/0047322 that shows swage expansion of one tubular inside another with no use for centralizers or any positioning of

the tubular after delivering it. The reason is the inner tubular is fully expanded into the surrounding tubular. This design has no need for creating an annular space for any purpose after delivery. It simply expands the inner tubular from within no matter how it sits initially in the surrounding tubular. The expansion is concluded when the inner tubular has been expanded fully against its surrounding tubular. The Examiner supposes two things about this reference. First is that the delivering equipment would do a positioning function for the inner tubular when that conclusion is not supported by the Maguire specification. Secondly, the Examiner suggests that positioning the tubular after running it into a surrounding tubular would even matter when the inner tubular is plastically deformed to a bigger diameter than the initial inside diameter of the outer tubular. In other words, this reference uses a method that has no need for positioning after delivery and therefore it fails to render claim 1 obvious where claim 1 envisions performing steps that are not stated or not needed to perform the Maguire method. Claims 1,2,4,6 and 9 are not obvious in view of Maguire.

Allowance of the remaining claims is respectfully requested.

Respectfully submitted,

December 15, 2005



Gary R. Maze  
Reg. No. 42,851  
Duane Morris LLP  
3200 Southwest Freeway, Suite 3150  
Houston, TX 77027  
Phone: 713.402.3900  
Fax: 713.402.3901



# **CERTIFICATE OF MAILING 37 CFR 1.10**

I hereby certify that this correspondence along with any referred to as attached or enclosed is being deposited with the United States Postal Service as Express Mail, Label No. EV572318211, postage prepaid in an envelope addressed to: Mail Stop Appeal Brief Patents, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on December 15, 2005.

  
\_\_\_\_\_  
Tracie Thigpen

## CLAIMS APPENDIX

The following claims are rejected and are the subject of this appeal.

1. (Previously presented) A method of positioning a tubular in a borehole, comprising:  
delivering the tubular into the borehole;  
positioning the tubular in the borehole, after said delivering, in a manner that leaves an annular space around it; and  
expanding the tubular.
2. (Original) The method of claim 1, comprising:  
providing a plurality of openings in said tubular;  
disposing an extendable member in each said opening.
3. (Original) The method of claim 2, comprising:  
keeping said extendable members substantially within said tubular for run in.
4. (Original) The method of claim 2, comprising:  
providing a closed end on at least one of said extendable members wherein said closed end is selectively driven toward the borehole wall.
5. (Original) The method of claim 2, comprising:  
providing an open end on at least one of said extendable members wherein said open end is selectively driven toward the borehole wall.
6. (Original) The method of claim 2, comprising:  
driving at least one of said extendable members toward the borehole wall with said expansion.

7. (Original) The method of claim 2, comprising:

driving at least one of said extendable members toward the borehole wall prior to said expansion.

8. (Original) The method of claim 7, comprising:

locking at least one of said extendable members against collapse after said driving.

9. (Previously presented) The method of claim 2, comprising:

penetrating the borehole wall with at least one of said extendable members.

10. (Original) The method of claim 9, comprising:

providing an open leading end on at least one of said extendable members to facilitate said penetrating.

11. (Original) The method of claim 7, comprising:

using internal pressure for said driving.

12. (Original) The method of claim 7, comprising:

using mechanical force for said driving.

13. (Original) The method of claim 3, comprising:

allowing said extendable members to extend no further than an upset or a coupling at a joint on said tubular prior to extending.

14. (Original) The method of claim 1, comprising:

expanding said tubular with a swage.

15. (Original) The method of claim 1, comprising:

expanding said tubular with internal pressure.

18. (Original) The method of claim 2, comprising:

delivering a sealing material under pressure through said tubular;

delivering the sealing material to said annular space;

expanding the tubular before the sealing material sets up.

19. (Original) The method of claim 18, comprising:

providing an open end and a closed end on at least one of said extendable members.

20. (Original) The method of claim 19, comprising:

driving one of said ends into the borehole with at least one of applied pressure or force from within the tubular and physical expansion of the tubular.

## **EVIDENCE APPENDIX**

The four patents cited by the Examiner to reject the claims are attached as the evidence in this appeal.

## **RELATED PROCEEDINGS APPENDIX**

There are no related proceedings.